

Definitions and Claim Chart:

In order to better show how the presently claimed invention is not obvious over the references, each reference has been explained above and both are set forth in a claim chart below which shows why the two references do not teach the claimed invention.

It is important to note that each word in the claim is important and should use the inventor's definition as set forth in the "Definitions" set forth below. An applicant may be her own lexicographer. *Markman v. Westview Instruments, Inc.*, 50 USPQ2d 1607 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996).

Definitions:

Some of these terms set forth in the specification have special meanings as follows:

1. Literary work – "At a minimum, a literary work must comprise at least 100 words or more and constitute an original work of authorship." See page 3, lines 24 and 25.
2. Associated with an advertisement – "Associated with an advertisement (e.g., a corporate name, a product name, a slogan, logo, icon, web site address, sound, description or illustration of product or service, or other promotional device).

Some or all of the playing pieces may not include advertisements, but could instead be distributed in conjunction with an advertising campaign. As one example, a competition sponsor may distribute pieces from its stores or by mail

with the advertising implicit in the distribution from the sponsor.” See page 4, lines 2 to 8.

3. Playing pieces – “Playing pieces can comprise physical objects (e.g. cards, plastic tablets, and the like) or an intangible object (e.g., a computer-generated display on a web page. Combinations of the two are also possible, such that some playing pieces are distributed in the form of physical objects while other playing pieces are distributed over the Internet (e.g., displayed on the web sites of sponsors.” See page 5, lines 14 to 18.
4. Prize – “A prize such as books, cash, scholarships, computers, trips, awards, recognition, or the like.” See page 6, lines 11 and 12.
5. Distinct parts – “distinct parts, each of which has no readily apparent relation to the other parts.” See page 2, line 17. “Distinct part of the same literary work that contain a number of words, but which cannot be readily correlated with other playing pieces without reading the distinct part of the literary work in each playing piece.” See page 5, lines 1 to 3.

Claim 26 must be interpreted in the light of the special definitions as set forth above.

Claim Chart:**Table 1 – Comparison of elements of claim 26 with Hopkins and Pritchard:**

Claim 26	Hopkins	Pritchard
A. A method for promoting literacy and reading by conducting a competition related to a literary work in association with an advertisement, comprising:	<p>No. Hopkins disclosure does not relate to promoting literacy and reading. Likewise, it does not show a competition related to a “literary work”.</p> <p>It is to be noted that the literary work must be at least 100 words and constitute an original work of authorship.</p> <p>Instead, Hopkins is a puzzle lottery in which all the puzzles are <u>pictures</u>. There is no method for promoting <u>literacy and reading</u>.</p>	<p>No. Pritchard’s disclosure does not relate to promoting literacy and reading. Likewise, it does not show any competition nor is there any competition related to a “literary work”.</p> <p>It is to be noted the literary work must be at least 100 words and constitute an original work of authorship.</p> <p>Instead, Pritchard is a picture-puzzle with pictures on all the individual stamps and with a few words on some of the stamps. Even when assembled, there is no message shown that is longer than 28 words and this is far short of the definition of literary work used by the applicant.</p>
B. dividing a literary work comprising a correctly ordered sequence of words into a plurality of distinct parts, each part having no readily identifiable means for determining the correct sequence of words in said literary work;	<p>No. There is no teaching of dividing a “literary work”. There is no teaching of a “correctly ordered sequence of words” and no “distinct parts” for determining “the correct sequence of words in said literary work”.</p>	<p>No. There is no teaching of dividing a “literary work”. There is no teaching of “distinct parts” for determining “the correct sequence of words in said literary work”. There is no “literary work”.</p>

Claim 26	Hopkins	Pritchard
C. creating a plurality of playing pieces, each of said playing pieces comprising one of said distinct parts;	No. There is no creating playing pieces where the pieces “comprise one of said distinct parts”. As used herein, the definition for said “distinct part” includes a relationship to the literary work. See page 5, lines 1 to 3.	No. There is no creating playing pieces where the pieces “comprise one of said distinct parts”. As used herein, the definition for said “distinct part” includes a relationship to the literary work. See page 5, lines 1 to 3.
D. creating an advertisement		
E. distributing said plurality of playing pieces comprising one of said distinct parts to members of the public in association with said advertisement	No. There is no teaching of distributing the playing pieces, which has a “distinct part” as that term is used herein. “Distinct part must include a relationship to the literary work.	No. There is no teaching of distributing the playing pieces, which has a “distinct part” as that term is used herein. “Distinct part must include a relationship to the literary work.
F. collecting said playing pieces comprising one of said distinct parts;	No. There is no teaching of collecting “said playing pieces comprising one of said distinct parts” as that term is used herein.	No. There is no teaching of collecting “said playing pieces comprising one of said distinct parts” as that term is used herein.
G. sequencing said playing pieces into a correctly ordered sequence of words in said literary work;	No. There is no teaching of “sequencing said playing pieces into a correctly ordered sequence of words in said literary work”. There are no words in Hopkins’ puzzle.	No. There is no teaching of “sequencing said playing pieces into a correctly ordered sequence of words in said literary work”. There is no sequencing of words in a literary work.
H. sending said correctly ordered set of playing pieces, or an identifier thereof, that represents the correctly ordered sequence of words in said literary work; and	No. There is no teaching of “sending said correctly ordered set of playing pieces, or an identifier thereof, that represents the correctly ordered sequence of words in said literary work”. There are no words in Hopkins’ puzzle.	No. There is no teaching of “sending said correctly ordered set of playing pieces, or an identifier thereof, that represents the correctly ordered sequence of words in said literary work”. There is no sequencing of words in a literary work.

Claim 26	Hopkins	Pritchard
I. winning a prize for said correctly ordered set of playing pieces that represents the correctly ordered sequence of words in said literary work.	No. There is no teaching of winning a prize “for said correctly ordered set of playing pieces that represents the correctly ordered sequence of words in said literary work”. There are no words in Hopkins’ puzzle.	No. There is no teaching of winning a prize “for said correctly ordered set of playing pieces that represents the correctly ordered sequence of words in said literary work”. There is no sequencing of words in a literary work.

Comments as to the Applicable Law:

As can be seen from the above claim chart, most elements of claim 26 are not found in the two references and the claimed invention is clearly patentable thereover. Indeed, most of the steps are not shown in either reference. It is believed the Examiner has used Applicant’s own disclosure as a blueprint to try and mosaic together components from two different references to attempt to show the claimed invention. This is a classic case of hindsight knowledge. If one of ordinary skill in the art had both references prior to Applicant’s invention, they would never have created the claimed invention. This is in effect “using that which the inventor has taught against its teacher”. (W.L. Gore v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983).

The law requires that, in order to prevent the use of hindsight based on the invention to defeat patentability of the invention, there must be shown a motivation to combine the references that create the case of obviousness, in other words, there must be shown reasons that the skilled artisan, confronted with the same problems as the inventor

and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). The central question is whether there is a reason to combine the references, a question of fact drawing on the Graham factors.

The factual inquiry whether to combine references must be thorough and searching. *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding”) (quoting *C. R. Bard, Inc. v. M3 Systems, Inc.*, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998); *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”); *In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (“there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant”); *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“teachings of references can be combined only if there is some

suggestion or incentive to do so.”) (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp. 221 USPQ 929, 933 (Fed. Cir. 1984).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); *In re Rouffet*, 149 f.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.”).

However, even though the two references should not be combined, neither teaches either singularly or in combination Applicant’s claimed invention.

The dependent claims 27 and 28 should be allowable for the same reason claim 26 is allowable.

The very essence of Applicant’s invention of a method for promoting literacy and reading is simply not shown by the two references. Each of the references relates primarily to pictures or illustrations and do not relate to promoting literacy and reading.

It is believed the three claims are clearly patentable in their present form.